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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1928

POWERS-KENNEDY CONTRACTING CORPORATION and ANTHONY G. FLECK
Petitioners

v.

CONCRETE MIXING & CONVEYING COMPANY
Respondent

No. 3

RESPONDENT'S BRIEF ON PETITION FOR CERTIORARI

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Supreme Court of the United States

OCTOBER TERM, 1928.

POWERS-KENNEDY CONTRACTING CORPORATION and ANTHONY G. FLECK, *Petitioners,* v. CONCRETE MIXING & CONVEYING COMPANY, *Respondent.*	No. 501.

RESPONDENT'S BRIEF ON PETITION FOR CERTIORARI.

It is conceded that this is a proper case for the issuance of a writ of certiorari, but for the following reasons only.

1. The Circuit Court of Appeals for the Ninth Circuit has held the McMichael patent in suit No. 1,127,660 invalid in respondent's suit against R. C. Storrie & Co., in which Claims 2, 17, 34 and 35 of the patent, which were sustained in this suit, were also involved.

2. The decision of the Circuit Court of Appeals for the Ninth Circuit holds in effect that the subject-matter of the patent in suit is unpatentable and that the patent is therefore invalid, whereas the Circuit of Appeals for the Second Circuit in this suit holds in effect that the subject-matter is patentable and that the patent is therefore valid.

3. Only a decision by this Court can settle this conflict of decisions, which is a real conflict and leaves the validity of the patent in dispute.

4. The alleged infringing apparatus of the defendants in this suit and that of the defendants in the suit before the Circuit Court of Appeals for the Ninth Circuit are both covered by Claims 2, 17, 31 and 35, involved in both suits, if valid.

5. This respondent has filed in this Court a petition for writ of certiorari to the Circuit Court of Appeals for the Ninth Circuit to review the decision of that Court in the said suit against R. C. Storrie & Co., and prays therein that the said decision be reversed (see No. 528 Oct. Term, 1928, filed Nov. 5 , 1928).

It is contended by the respondent that the decision of the Circuit Court of Appeals for the Second Circuit in this case is correct, and should be affirmed, and that the decision of the Circuit Court of Appeals for the Ninth Circuit is erroneous, for the following reasons, among others:

1. The patent in suit has been twice considered by the Circuit Court of Appeals for the Second Circuit and in both cases has been held valid and infringed, affirming the decisions of the District Court to the same affect. The first decision was in the suit of this respondent against Ulen Contracting Corporation, *et al.* (12 Fed. [2d] 929,931) and the second in the present suit of the petitioner against Powers-Kennedy Contracting Corporation, *et al.* In both these decisions, as well as in the decisions of the District Court, the subject-matter of the patent in suit was considered in its entirety, as defined by the claims, this subject-matter including certain vital and indispensible elements, viz.: (a) a chamber adapted to be sealed, except at its discharge outlet, for receiving a mass of concrete, (b) a conveying conduit leading from said outlet to a distant point of delivery, (c) means for introducing compressed air back of or behind the mass

of materials in the chamber, and (d) means for injecting compressed air into the concrete at the outlet to detach successive portions of the mass under pressure and propel them into and through the conduit to the place of delivery, whereby the heavy homogeneous mass of intimately mixed rock, sand, cement and water is discharged from the chamber and forced into and through the conduit to the place of delivery substantially intact. This was never accomplished, with concrete or any other material, before, and no apparatus like that of the patent or for accomplishing this result in any manner is found in the prior art disclosed by the records of the three suits.

The Circuit Court of Appeals for the Ninth Circuit on the other hand did not consider the subject-matter of the patent in its entirety, but disregarded the nozzle or means for injecting compressed air at the outlet, positioned and arranged as specified, which is *the most vital and essential element*. This is shown by the language of their decision in which they say, referring to the principal prior patent (Smith No. 122,198 of 1872) in both pending suits:

> "The device contained all the features of the appellant's patent except the nozzle for admission of air near the point of exit." (All decisions printed in Appendix of Petition.)

2. The disclosure of the prior art in all three records is substantially the same. The decision of the Second Circuit Court of Appeals is based upon the subject-matter of the patent as described and claimed, and the decision of the Ninth Circuit Court of Appeals is based upon that subject-matter deprived of its most vital and essential element. The conflict between the two decisions, therefore, is not due to any difference in the records before the respective courts but to an erroneous definition of the subject-matter by the Court of Appeals for the Ninth Circuit, which was contrary to the disclosure and definition

of the patent itself and to the uncontroverted evidence as to its essentials.

The decision in the *Ulen* suit was rendered by Judge A. N. HAND in the District Court and affirmed by Judges ROGERS, HOUGH and MACK in the Second Circuit Court of Appeals. The decision in the Powers-Kennedy suit was also rendered in the District Court by Judge A. N. HAND and affirmed by a majority of the Court consisting of Judges SWAN and LEARNED HAND, Judge MANTON of that Court dissenting, but without opinion or memorandum. The decision in the District Court in the *Shonle* case was rendered by Judge BOURQUIN and was affirmed by Judges GILBERT, BUDKIN and DIETRICH in the Ninth Circuit Court of Appeals. The patent has therefore been sustained by one District Judge (twice) and five Judges sitting in the Appellate Court and held invalid by one District Judge and three Judges in the Appellate Court. Whether Judge MANTON's dissent was on the ground of invalidity or non-infringment, or both, does not appear. Assuming, however, that it was based on invalidity, we have six Judges holding the patent valid and five holding it invalid.

3. The decision of the Circuit Court of Appeals for the Ninth Circuit apparently not only treats as an anticipation the Smith patent which lacks the most vital element of the patent in suit, but appears to accept the Duckham British patents of 1875 and 1885 as anticipations, in spite of the fact that this vital element is not shown nor described in these foreign patents, the nozzle referred to in them being given no particular location and a function radically different from that of the nozzle of the patent in suit. It further appears to accept as a prior use an experiment by one Leake, although this experiment was (a) supported solely by the vague and indefinite testimony of Leake, without substantiation or corroboration of any kind in matter originating prior to the application

for the patent in suit, which (b) admits that the vital element of the nozzle at the outlet was lacking, and (c) is the testimony of a man who permitted McMichael to receive the award of priority over him in the Patent Office. The Court also erroneously accepted *ex parte* statements made by Leake and his attorney in the Patent Office as evidence, the latter unverified and evidently based on hearsay, and relating to matters subsequent to the application for the patent in suit.

1. The Court of Appeals for the Ninth Circuit did not correctly apply to the state of facts before it the decision of this Court in *Concrete Appliances Co.* v. *Gomery*, 269 U. S. 177, which recognizes that where structural changes are necessary in the adaptation of an old apparatus to the handling of new and different material for which it was not previously adapted, as in the present case, invention of the highest order may be involved. The Court assumed that the fact that the Duckham apparatus "was engaged in moving a material quite different from concrete" "is not of importance on a question of anticipation," whereas it is of the highest importance on a question of anticipation if, as in the present case, the handling of the new material necessarily involves an unobvious change in structure or method of operation not found in prior devices or methods. In the *Gomery* case no material change was required to adapt the old devices to the gravity distribution of concrete, and further as the Court of Appeals for the Third Circuit said (291 Fed. 486, 489): "substantially similar concrete chuting apparatus" was shown to have been used prior to the application for the patent there in suit.

On the other hand the Court of Appeals for the Second Circuit correctly interpreted the decision of this Court in *Concrete* v. *Gomery*, as based on the finding that the patent there in suit

> "* * * merely made use of known methods and appliances for the convenient handling of this recently accepted building material" * * *

and further on the well recognized principle of law

> "* * * that old apparatus used for distributing water, grain or coal was readily adaptable for handling concrete," * * *

and therefore no invention was involved in making this ready adaptation. The fact that the Second Circuit Court of Appeals further noted that such adaptations had been made prior to the application for the patent in the *Gomery* suit does not, as contended by the petitioner, mean that it distinguished the *Gomery* case on that ground. It means nothing more than that the Court, while recognizing the full weight of the decision on the question of law involved, noted the fact stated as indicating a reason for the application of the law which does not exist in the present case.

The decision of the Second Circuit Court of Appeals was therefore correct in holding that because the adaptation had never been made, was far from obvious and involved a new method of operation, invention was involved; and that

> "to do this was to make a new machine, and one who thought of doing it would have had a new and inventive idea;" * * *.

The fact alone that no device of the prior art, for handling any material, disclosed the idea or plan of maintaining the material in a closed vessel with compressed air behind it forcing it into the outlet *as a mass* and injecting into it *at the outlet a velocity jet of compressed air* to detach successive portions of the mass and drive them to and through the conveying conduit, was suffi-

cient to support this finding, without the added evidence that this plan *though long needed was never employed and when adopted went into universal use, supplanting other means, and performing work of inestimable value.*

5. The Court of Appeals for the Second Circuit was correct in finding that McMichael had the right to better explain his invention and claim it more fully during the pendency of his application in the Patent Office, without departing from his original disclosure, and that if he did add any matter to his application which was new in any sense it was covered by his new oath accompanying it (Ulen R., p. 251, Exhibit D, R., 45), thereby affirming the decision of his Honor, Judge LEARNED HAND (*Id.*, p. 13, R. 42), to that effect.

6. The Court of Appeals for the Second Circuit was not in error in holding that the machine of the patent in suit operates as described in the specification and is not open to attack on the ground that it does not.

7. The Court of Appeals for the Second Circuit was not in error in giving no weight to the article published in the Journal of the Western Society of Engineers in 1918 by Mr. Kirkland, or in giving it no weight as against the description of the operation of the invention as described and claimed in the patent in suit (see Exhibit H, R., 144, 147), because the statements in that article were unverified statements, were made by a person who had no interest in the patent in suit and no interest with any one but a mere licensee under the patent, were not made in this suit or any other suit and were corrected by Mr. Kirkland when called by the defendants as their witness.

The record in the *Ulen* suit should be included in the record in this suit to be certified, and incorporated in the printed record here as a paper exhibit.

This is the record in the suit of the respondent against Ulen Contracting Corporation, *et al.*, before the Court of Appeals for the Second Circuit in 1926 (see 12 Fed. [2nd] 929, 931), and was offered in evidence by the defendants at page 45 of the present record, after certain portions of it were offered (R., 42 and 43) as Plaintiffs' Exhibits 6, 7, 8 and 9. It is marked Defendants' Exhibit D (Index, R., VI), and was used in the District Court and in the Court of Appeals as evidence. Under the stipulation as to the appeal record (R. 436) this Exhibit D, Ulen record, was produced before the Second Circuit Court of Appeals in triplicate. It contains important evidence relating to the prior art, the operation and advantages of the patented invention and other matters, which is not in the transcript of record on this petition for writ of certiorari, but was considered by the District Court and the Second Circuit Court of Appeals in this suit. Without it the record before the Court of Appeals for the Second Circuit is incomplete.

CONCLUSION.

For the foregoing reasons, if the writ of certiorari is granted to review the decision of the Circuit Court of Appeals for the Second Circuit, the said decision of the Court should be affirmed, and the decision of the Circuit Court of Appeals for the Ninth Circuit reversed.

Respectfully submitted,

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